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WASHINGTON DC 20005

EXAMINER

AKERS, G

ART UNIT

PAPER NUMBER

2164

DATE MAILED:

07/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/227,406

Applicant
Miller

Examiner
Geoffrey Akers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 3, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-29 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The text of those sections of Title 35 US Code not included here can be found in a prior Office action(See serial No: 09/227,406).The text of those sections of Title 35 US Code not otherwise provided in a prior Office action will be included herein where appropriate.
2. This action is responsive to the amendment(C) filed 7/3/01(Paper #11).
- 3.Claims 1-12 were cancelled.Remaining claims 13-29 were examined.No new claims were added.
4. Examiner withdraws the finality of the Final Rejection issued 5/8/01. This is a second action non-final rejection.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claim 13,19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Lancelot et al (US 5,946,659). Lancelot was cited in the second IDS by the applicant submitted on February 1, 2000.
7. As per claim 13 Lancelot teaches a computer-implemented method for automating administrative procedures in a medical office,said method comprising the steps of:

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maintaining an office automation system including a database containing provider information and patient information;

Lancelot shows automation system in Fig. 1B with a description of the system in the paragraph starting on column 4, line 12.

generating reports from the office automation system, automatically populating fields in the reports with information from the database where appropriate; and

Lancelot discloses a database on column 6, line 50. Several reports are shown in Figures 10 to 12. In Figure 11, a choice list is shown which allows the user to populate the report with information from the database.

supporting performance of one or more administrative tasks by an off-site service provider, including managing an electronic information exchange between the off-site service provider and the office automation system.

Lancelot discloses off-site support computer in Fig. 1B.

8. As per claim 19 Lancelot teaches a storage medium containing a set of instructions for execution by a computer, the set of instructions serving to automate administrative tasks in a medical office, said set of instructions comprising instructions for:

maintaining an office automation system including a database containing provider information and patient information;

Lancelot shows automation system in Fig. 1B with a description of the system in the paragraph starting on column 4, line 12.

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generating reports from the office automation system, automatically populating fields in the reports with information from the database where appropriate; and

Lancelot discloses a database on column 6, line 50. Several reports are shown in Figures 10 to 12. In Figure 11, a choice list is shown which allows the user to populate the report with information from the database.

supporting performance of one or more administrative tasks by an off-site service provider, including managing an electronic information exchange between the off-site service provider and the office automation system.

Lancelot discloses off-site support computer in Fig. 18.

9. As per claim 20, Lancelot teaches the storage medium of claim 19, wherein said storage medium comprises a portable storage device.

Lancelot discloses a central computer which includes a "disc drive memory unit" as shown on column 6, line 42. Although a portable storage device is not specifically disclosed, a disc drive memory unit in computers normally consists of a hard drive and some sort of "floppy" disc drive.

10. As per claim 21, Lancelot teaches the storage medium of claim 19, wherein said storage medium comprises a memory of the computer. Lancelot discloses a central computer which includes a "primary memory unit 41, such as a random access memory unit" on column 6, line 39.

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11. Claims 22-29 are rejected under 35 U.S.C. 102(a) as being anticipated by Medical-ogids Logicon and related products. MedicaLogic is disclosed in four MedicaLogic press releases dated: January 27, 1997, February 17, 1997, October 27, 1997 and November 10, 1997. MedicaLogic is also disclosed in a June 1996 article in Health Management Technology by Dunbrack and in a June 5, 1995 article in Network World of June 5, 1995 by Messmer.

12. As per claim 22, Medicalogic teaches a computer-implemented subscription service for automating administrative procedures in a medical office, said subscription service comprising: maintaining a database at a subscriber service center, said database containing information relating to a plurality of subscribers; providing each of said subscribers with a computer-based office automation system configured to exchange data electronically with said subscriber service center; receiving at said subscriber service center a request for performance of an office administration task; performing the requested office administration task at said subscriber service center; and electronically transmitting information relating to performance of the office administration task back to said computer-based office automation system.

These features are shown starting in the first paragraph on the second page of the February 17, 1997 MedicaLogic press release which describes the features of Logician 4.2. Links to any clinical data repository, electronic links and administrative tasks are disclosed. Database functionality is also disclosed in the Network World article of June 5, 1995 on the second column.

MedicaLogic discloses subscription service in the- Dunbrack article. On page 34, first column, MedicaLogic integrated Logicon with Reynolds and Reynolds' R2000 product. On the

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same page on the next column, it was disclosed that Reynolds and Reynolds' R2000 has been implemented in almost 100 service bureaus.

13. As per claim 23, Medicalogic the computer-implemented subscription service of claim 22, wherein the requested office administration task comprises transcription of a dictation tape. Medicalogic discloses transcription in the January 27, 1997 press release.

14. As per claim 24 Medicalogic teaches the computer-implemented subscription service of claim 23, wherein the information relating to performance of the office administration task comprises a computer file containing a transcription of the dictation tape.

Medicalogic discloses transcription in the January 27, 1997 press release and the methodology is explained in the bottom of the first page and top of the second page.

15. As per claim 25, Medicalogic The computer-implemented subscription service of claim 22, wherein the information relating to performance of the office administration task comprises status information.

This feature is disclosed in the February 17, 1997 Medicalogic press release on the third full paragraph of the second page.

16. As per claim 26, Medicalogic teaches the computer-implemented subscription service of claim 22, further comprising the step of generating a report from the computer-based office automation system using the information relating to performance of the office administration task.

This feature is disclosed in the February 17, 1997 Medicalogic press release on the third full paragraph of the second page.

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17. As per claim 27, Medicalogic teaches the computer-implemented subscription service of claim 22, wherein the requested office administration task comprises chart preparation.

Electronic charts are disclosed by MedicaLogic in the January 27, 1997 press release in fourth paragraph.

18. As per claim 28, Medicalogic teaches the computer-implemented subscription service of claim 22, wherein the requested office administration task comprises report generation. Reports are disclosed by MedicaLogic in the November 10, 1997 press release in the fourth paragraph, which discusses decision support.

19. As per claim 29, Medicalogic teaches the computer-implemented subscription service of claim 22, wherein the requested office administration task comprises forms generation. This feature is disclosed by MedicaLogic in the Network World article of June 5, 1995.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lancelot as applied to claim 13 above, and further in view of Jachmann et al (US 5,146,439). Jachmann discloses records management system with dictation/transcription capability

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22. As per claim 14, Lancelot teaches the computer-implemented method of claim 13, wherein said step of supporting performance of one or more administrative tasks by an off-site service provider comprises supporting off-site tape transcription.

Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an off-site service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and medical office uses are disclosed in the abstract. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.

23. As per claim 15, Lancelot teaches the computer-implemented method of claim 14, further comprising the step of maintaining information relating to a current workload for each of a plurality of off-site transcriptionists.

Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an offsite service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and priority assignment in Fig. 2A. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.

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24. As per claim 16, Lancelot the computer-implemented method of claim 15, further comprising the step of assigning a transcription tape to an off-site transcriptionist based upon the current workload information.

Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an offsite service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and priority assignment in Fig. 2A. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.

25. As per claim 17, Lancelot teaches the computer-implemented method of claim 14, further comprising the step of receiving an electronic transmission of a transcribed report from an off-site transcriptionist.

Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an offsite service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and methods for sending transcribed report from an off-site transcriptionist are shown in Fig. 28. It would have been obvious to combine Lancelot and Jachmann since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful.

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26. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lancelot as applied to claim 13 above, further in view of Jachmann, and further in view of Kerrigan. Kerrigan discloses in an article in Computer in Healthcare of December 1987 how hospitals are using services such as transcription to make a profit.

27. As per claim 18, Lancelot, teaches the computer-implemented method of claim 13, wherein said method is provided as a subscription service.

Lancelot discloses a computer-implemented method for automating administrative procedures in a medical office as shown in claim 13 above with an offsite service provider, but does not disclose off-site tape transcription. Jachmann discloses off-site tape transcription as shown in column 3, line 12 and medical office uses are disclosed in the abstract, but does not disclose payment. Kerrigan discloses how Piedmont Hospital was charging doctors for transcription services in 1987 as shown in the first column of page 36. It would have been obvious to combine Lancelot, Jachmann and Kerrigan since the addition of off-site transcription is disclosed by Jachmann and would make Lancelot's application more useful and payment is a necessary function of any business service.

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Conclusion

28. **THIS ACTION IS MADE NON FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Questions concerning this communication should be addressed to the examiner, Dr. Geoffrey Akers, P.E. who can be telephoned at (703)-306-5844 between the hours of 6:30 AM and 5:00 PM Monday through Friday. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Vincent Millin, SPE, may be contacted at (703)-308-1065.

GRA

July 18, 2001


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